

REMARKS

Based on the following, Applicant contends that all pending claims are in condition for allowance, and reconsideration of the rejection of the pending claims is respectfully requested. No new matter has been added.

A number of claims have been canceled without prejudice and with the right to continue arguing their allowance in a subsequent continuation. The remaining claims, as amended and argued, are presented to advance prosecution.

Defective Oath:

The Office Action requires that a new oath be provided which is compliant with 37 C.F.R. § 1.67(a). Accordingly, a new oath is provided herewith.

Objections to the Drawings:

The drawings are objected to because on page 9, line 10 (paragraph [0039]), the specification refers to gaming terminal 1240. However Figure 12 shows game display 1240 within gaming terminal 1200. Paragraph [0039] has been amended to recite “game display 1240” in place of “gaming terminal 1240” on page 9, line 10 of the specification as filed. The Office Action also notes that the specification, on page 10, line 21, (paragraph [0043]) refers to “gaming terminal 1210” instead of “game control 1210.” Paragraph [0043] has been amended to properly recite “game control 1210” in place of “gaming terminal 1210.”

The Examiner is thanked for noting the above matters in Applicant’s specification. In view of the amendments to the specification discussed above, it is submitted that the drawings and specification are in correspondence with each other and that the drawings are now fully compliant with all applicable rules. Applicant therefore respectfully requests reconsideration of the objection to the drawings.

No amendments to the drawings are required and the objections are overcome.

Amendments to the Specification and Abstract:

Specification paragraphs [0039] and [0043] have been amended as described in the “objections to the drawings” section above. Paragraph [0049] has also been amended to recite the word “five” in place of the word “nine” prior to the language “reel casino slot game .

..." Support for this change is present in paragraph [0049] and in Figure 9 in the application as filed. Separately, in accordance with the Office Action's admonitions regarding the proper form for the abstract, a new, compliant abstract has been provided.

Objections to the Claims:

Claim 5 is objected to because of informalities identified in the Office Action. Claim 5 has been canceled without prejudice, and the objection thereto is therefore considered moot.

Rejection under 35 U.S.C. § 112, First Paragraph:

Claims 3-4 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action asserts that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses the outstanding rejection.

The Office Action recites:

"The examiner believes, as claimed, that there would be a one to one correspondence between the frequency of entering the normal play mode from the free play mode and vice versa. Therefore, having a frequency of entering the free play mode from the normal play mode being less than the frequency of entering the normal play mode from the free play mode would be impossible." (emphasis added)

Applicant respectfully disagrees.

Claim 3 recites: "the frequency of entering the free play mode from the normal play mode." An example of such a frequency is provided on page 4, paragraphs 0052-0053. This example is the message symbol M randomly appearing 3 in 63 spins (averaged over a long period of time). In response to this appearance of the message M symbol, the player must select a symbol in the game outcome. The odds of the player selecting the free spin symbol are 1/14 (in the example), so this overall frequency is $1/14 \times 1/63$ or 1/294 spins. The frequency of entering free mode play is 1/294 spins of normal play.

Claim 3 further recites: "the frequency of entering the normal play mode from the free play mode." This refers to the frequency of the stop symbol appearing in the free play mode. An example of which is provided at paragraph 0054 of 1/21 spins (averaged over a long period of time). The frequency entering normal play mode is 1/21 spins of free play.

Thus, the specification fully enables the precise language of claim 3 that 1/294 spins (entering free play from normal play) is "less than" 1/21 spins (entering normal play from free play). With respect to this example, the specification at paragraph 0054 states:

"A player of this embodiment of the casino game of chance, over a long period of time; spends fourteen times as much time in the normal play mode as the free play mode."

Claims 3-4 are fully enabled under 35 U.S.C. § 112, first paragraph by an actual example.

Rejection under 35 U.S.C. § 112, Second Paragraph:

Claims 5, 7, 8, 9, and 25-29 are rejected under 35 U.S.C. § 112, second paragraph. Claims 5 and 25-29 have been canceled.

Claim 7 has been amended to provide the proper antecedent basis for "the normal-play-mode award." Claims 7, 8 and 9 are in condition for allowance.

Rejection under 35 U.S.C. § 102(b):

Claims 1, 2, 5, 6, 7, and 9-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Slomiany et al. (U.S. Patent No. 6,159,098, hereafter Slomiany). Claims 5, 14 and 25-29 have been canceled.

Independent claims 1 and 15 have been amended to further recite:

"randomly displaying, in response to the game outcome, a message to the player to select a symbol in the game outcome,"

"receiving an input in the casino game from the player selecting a symbol in a plurality of symbols in the game outcome"

Independent claim 6 recites randomly displaying "a special symbol" in the game outcome to the player to select a symbol in the game outcome. Slomiany does not disclose or infer such a feature. There is no "message" or "special symbol" disclosed in the slot game of Slomiany requesting the player to select a symbol in the game outcome of the slot game of Slomiany and receiving the player input. There is no "message" or "special symbol" disclosed in the bonus game of Slomiany requesting the player to select a symbol in the displayed 10 symbols (pigs) as the processor randomly selects one (column 7, line 16). For this reason alone, claims 1, 6 and 15 are patently distinct over the cited reference.

Independent claim 1 further recites:

"revealing a hidden value behind selected symbol"

Independent claims 6 and 15 further recite:

"when the selected symbol reveals a free play symbol"

Neither the slot game or the bonus game of Slomiany "reveals" a value such as an award or free play symbol when selected by a player. Each Slomiany pig, when selected by the processor, changes to a "bomb symbol of zero value" (column 7, lines 33-37). This is not a hidden value as the Slomiany player always knows the processor selected pig will become a bomb symbol. Furthermore, the Slomiany bomb symbol functions to stop play of the bonus game! The player selected symbol of the claimed invention reveals either an award or free play. When the selected symbol of the present invention is a free play symbol, play continues! The exact opposite of the disclosure of Slomiany. For this reason alone, all the claims are patentably distinct over Slomiany and allowance is respectfully requested.

With respect to the individual rejections starting on page 7 through 12, the above amendments render these rejections moot with respect to the remaining independent claims 1, 6 and 15.

With respect to dependent claims 7 and 9, Figure 5 of Slomiany shows preset awards such as 4 coins (column 7, line 9). There is no disclosure in Slomiany of multiplying the base game outcome by the pig selection in the bonus game.

Dependent claim 10 has been amended to recite "playing" and when read with claim 6 is patentably distinct over Slomiany. It is recognized that the words of claim 10, alone, are old and well known to the gaming industry.

Dependent claims 11 and 12 when read with claim 6, as a whole, are patentably distinct over Slomiany.

With respect to dependent claim 13, this feature is not found in Slomiany. Slomiany has pigs and as long as a pig is selected, bonus play continues. Once selected a pig becomes a bomb and when a bomb is selected, the game is over. There is no teaching of a free spin symbol randomly provided among a plurality of symbols in a game outcome of the free play mode.

When claim 16 is read with claims 15 and 17 it is patentably distinct over the cited reference.

With respect to claims 18 and 19, the Slomiany disclosure at column 7, lines 1-47 does not teach this. Clearly each pig, when selected, adds a bomb. The first play of Slomiany results in no bombs being possible, so always an award (not true in the present invention as a stop symbol can randomly occur in the first game outcome of the free play mode). Each Slomiany play causes a new bomb, so the probabilities always change and increase during continued play (not true in the present invention as the probabilities are fixed over time as to when free play is entered and when a stop is encountered).

All pending claims are not anticipated nor rendered obvious by Slomiany.

Rejection under 35 U.S.C. § 103(a):

Claim 8 is rejected as being unpatentable over Slomiany under 35 U.S.C. § 103(a). The arguments set forth above are incorporated by reference. Claim 3 when read with claim 1, as amended, and as a whole is non-obvious over the cited reference.

New Claims:

The new claims are dependent from claim 1 and recite additional method step details not found in the cited reference. Claims 30, 31 and 33 are shown in Figures 2 and 3. New claim 32 is shown in Figure 11. New claim 34 is discussed at page 2, paragraph 0035.

Conclusion:

No art has been cited against claims 3 and 4 and these claims are fully enabled. Based on the foregoing, all pending claims rejected based on Slomiany are in condition for allowance. Applicant respectfully requests that the instant case be passed to issue.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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